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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,660	01/16/2002	Henry Yue	PF-0714 USN	4258

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EXAMINER	
STRZELECKA, TERESA E	
ART UNIT	PAPER NUMBER
1637	

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/031,660	YUE ET AL.	
	Examiner	Art Unit	
	Teresa E Strzelecka	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-28* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Note about claims 1, 5 and 17: in claim 1, polypeptides with SEQ ID NO: 1-66 are claimed, whereas in claim 17 polypeptides with SEQ ID NO: 67-132 are claimed. However, SEQ ID NO: 67-132 seem to be assigned to polynucleotides in claim 5.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-66, claim(s) 1, 2, 16, 17, all in part, drawn to a technical feature of an isolated polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 67-132, claim(s) 3-8, 11, 12, (all in part) drawn to a technical feature of an isolated polynucleotide selected from the group consisting of SEQ ID NO: 67-132, the polynucleotide encoding a polypeptide.

Groups 133-198, claim(s) 9, in part, drawn to a technical feature of a method of producing a polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 199-264, claim(s) 10, in part, drawn to a technical feature of an isolated antibody which specifically binds to a polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 265-330, claim(s) 13, 14, (all in part) drawn to a technical feature of a method of detecting target polynucleotide selected from the group consisting of SEQ ID NO: 67-132, by hybridizing to a sample a probe comprising at least 20 nucleotides complementary to the target.

Groups 331-396, claim(s) 15, in part, drawn to a technical feature of a method of detecting target polynucleotide selected from the group consisting of SEQ ID NO: 67-132 by amplifying the target polynucleotide using PCR.

Groups 397-462, claim(s) 18, in part, drawn to a technical feature of a method of treating a disease or condition associated with decreased expression of functional GBAP by administering

to a patient a composition comprising a polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 463-528, claim(s) 19, in part, drawn to a technical feature of a method of screening a compound for effectiveness as agonist of a polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 529-594, claim(s) 20, in part, drawn to a technical feature of a composition comprising an agonist of a polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 595-660, claim(s) 21, in part, drawn to a technical feature of a method of treating a disease or condition associated with decreased expression of functional GBAP by administering to a patient a composition comprising an agonist of a polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 661-726, claim(s) 22, in part, drawn to a technical feature of a method of screening a compound for effectiveness as antagonist of a polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 727-792, claim(s) 23, in part, drawn to a technical feature of a composition comprising an antagonist of a polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 793-858, claim(s) 24, in part, drawn to a technical feature of a method of treating a disease or condition associated with overexpression of functional GBAP by administering to a patient a composition comprising an antagonist of a polypeptide selected from the group consisting of SEQ ID NO: 1-66.

Groups 859-924, claim(s) 25, in part, drawn to a technical feature of a method of screening for a compound that specifically binds to a polypeptide selected from the group consisting of SEQ ID NO: 1-66 by contacting the polypeptide with at least one test compound and detecting binding of the polypeptide.

Groups 925-990, claim(s) 26, in part, drawn to a technical feature of a method of screening for a compound that modulates the activity of a polypeptide selected from the group consisting of SEQ ID NO: 1-66 by contacting the polypeptide with at least one test compound, assessing the activity of the polypeptide and comparing the activity of the polypeptide with test compound to the polypeptide without test compound.

Groups 991-1056, claim(s) 27, in part, drawn to a technical feature of a method of screening for a compound for effectiveness in altering an expression of a polynucleotide selected from the group consisting of SEQ ID NO: 67-132 by contacting the polynucleotide with the compound and detecting detecting altered expression of the polynucleotide.

Groups 1057-1122, claim(s) 28, in part, drawn to a technical feature of a method of for assessing toxicity of a test compound, by treating a sample with the test compound, hybridizing to a sample a probe comprising at least 20 nucleotides complementary to the target polynucleotide selected from the group consisting of SEQ ID NO: 67-132, quantifying the amount of the hybridization complex and comparing the amount of hybridization complex in samples treated and not treated with the compound.

3. The inventions listed as Groups 1-1122 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: sequence with accession No. Q05473 (November 1996) discloses biologically active fragments of SEQ ID NO: 1 (amino acids 144-149, 166-170, for example; see sequence alignment).

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa E Strzelecka whose telephone number is (571) 272-0789. The examiner can normally be reached on M-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TS
April 14, 2004

JEFFREY FREDMAN
PRIMARY EXAMINER